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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,655	10/19/2000	Gary E. Smith	GSMITH.002A	7733

20995 7590 06/06/2002

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EXAMINER

THISSELL, JENNIFER I

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/692,655

Applicant(s)

SMITH, GARY E.

Examiner

Jennifer I Thissell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-15 and 18-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of the Restriction Requirement in Paper No. 4 is acknowledged. The traversal is on the ground(s) that applicant believes the independent claims are generic to Species A, B, and C. This is not found persuasive because applicant shows three patentably distinct figures in the drawings, as well as refers to these figures as "alternate embodiments" in the specification.

The requirement is still deemed proper and is therefore made FINAL. Applicant has elected Species A, and submits that claims 1, 2, 4-6, 8-15, and 18-31 correspond to the elected species. The Examiner acknowledges that applicant has chosen Species A and agrees that claims 1, 2, 4-6, 8-15, and 18-31 correspond to the elected species. Therefore, claims 3, 7, 16, and 17 are withdrawn from consideration.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim states that the roof tile is placed in contact "only" with the support element, however, because of the nature of the invention, the roof tile would also be in contact with another roofing tile or even a fastener, not "only" the support element.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 6, 9-11, 14, 15, and 19-22 are rejected under 35

U.S.C. 102(b) as being anticipated by Fifield ('940). Fifield teaches a support element 2 in between a roof tile 40 and a roofing surface, the support element is in the shape of a wedge, the support element is expanded polystyrene, the roofing surface is a roof deck with battens, the roof tile is lightweight concrete, the support element has a large surface area, and the first row of tiles are a distance above the second row.

Claims 1, 2, 4, 5, 8-10, 12, 14, 15, 18-25, and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Ilnyckyj ('888). Ilnyckyj teaches a wedge-shaped quadrilateral support element 60 made of polystyrene, there is a roofing deck 64 that inherently includes battens, the support elements are separate from the roof tiles 10, the support element has a large surface area, the support elements are arranged in rows, and the first row tile is a distance above the second tile.

Since applicant has not indicated in which order the method steps are performed in the claim, indicating a lack of criticality, it is the Examiner's position that Ilnyckyj teaches that the tiles are placed over the support elements, the support elements are placed on the roof, and the roof tile is secured to the roofing surface. The tile is in contact with the support element and the roofing surface.

Claims 1, 6, 8-10, 12-14, 20-23, and 26 are rejected, as understood, under 35 U.S.C. 102(b) as being anticipated by Matorell (FR #2583091). Matorell has a support element (Figure 4) that is placed on a roofing surface 6, and a roof tile (above the support element in Figure 4) is placed and secured over the support element, the roof tile does not contact the roof. The support element has at least one groove formed in the bottom surface, the roofing surface is a roof deck with battens, the support element supports a plurality of roof tiles, the roof tiles are arranged in rows, the first supported by support

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elements such that the roof tiles of the first row are elevated above a second row of tiles (Figure 4).

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I Thissell whose telephone number is (703) 306-5750. The examiner can normally be reached Monday through Thursday.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



May 30, 2002



Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600